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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,916	07/11/2003	Yutaka Tosaki	Q76524	2409
65565 7590 04/11/2007 SUGHRUE-265550 2100 PENNSYLVANIA AVE. NW WASHINGTON, DC 20037-3213			EXAMINER EGWIM, KELECHI CHIDI	
			ART UNIT	PAPER NUMBER
			1713	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/11/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/616,916

Applicant(s)

TOSAKI ET AL.

Examiner

Dr. Kelechi C. Egwim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 2 and 4-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Due to amendments with regard to MW and persuasive arguments by applicant, the previous rejections of record based on Kunihiro et al., have been overcome and are hereby withdrawn.

#### ***Claim Rejections - 35 USC § 102/103***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Iijima et al. or Rosenski et al., for reasons cited in the previous action.

***Response to Arguments***

5. Applicant's arguments and declaration filed 01/10/2007 have been fully considered but they are not persuasive.

6. Regarding the declaration filed 1/10/07, with regard to Iijima et al., firstly, applicant has not proved a 1-to-1 comparison of the prior art and the presently claimed method sufficient to demonstrate the essential exclusion of the low MW polyglycol of Iijima et al. The comparative experiment 2 appears to be an attempt at a 1-to-1 comparison, but falls far short of one. Since the disputed component, the low MW polyglycol, is added after the polymerization is complete, applicant need only add said component to the claimed emulsion polymer in order to demonstrate any deteriorative effect. The only polymer emulsion produced in applicant's disclosure or declaration, "Pressure Sensitive Adhesive A", comprises a multi-stage polymer (which is off course significantly more narrow than what is actually being claimed), yet the polymer emulsion used in Comparative Experiment 2 of the declaration is not such a multi-stage polymer.

Secondly, applicant's declaration must be commensurate in scope with what they are actually claiming. Applicant's sole exemplified emulsion polymer is a specific multi-stage polymer with a specific combination of monomers prepared in a specific stepwise manner, yet applicant is arguing that, based on their sole experiment of the single multi-stage polymer, that all "acrylic polymer (regardless of specific composition) having a glass transition point of -20°C or lower and a weight-average molecular weight of at least 200,000" in such a PSA dispersions will show the improved wet surface adhesive

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forces when compared to the same acrylic PSA with as much as 3% of low MW polyglycol is added. The experiments at hand are simply not commensurate with the scope of that is being claimed.

Further, applicant has not been entirely clear on what "comparative experiment 3" is supposed to be comparative with, with regard to the glycerin in question.

For the above reasons, applicant's declaration is not sufficient to overcome the present rejections over Iijima et al., based on the much broader scope of applicant's claims when compared to what they have actually demonstrated experimentally.

The declaration is insufficient to show that the small amount of the low MW compound required by Iijima et al. (3%) will adversely affect the adhesive as it is presently claimed.

7. Regarding the MW of the polyalkylene glycol in Iijima et al., the polyalkylene glycol with MW above 300,000 overlaps with applicants 100,000 to 3,000,000 sufficient to anticipate the claimed range. Applicant has not demonstrated any advantage with a polyalkylene glycol of MW below 300,000 over a polyalkylene glycol with MW above 300,000 in the same type of adhesive. Further, applicant's upper limit is so high and the range so wide that the claimed range is anticipated by the prior art disclosure, even without an explicit upper limit.

8. In response to applicant's argument that the adhesive of Iijima et al. has a different advantage for different application, a recitation of the intended use of the

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claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

9. Regarding Rosenski et al., as stated in the previous action, whether the polyglycol is added before or after polymerization, the product is the same as, or an obvious variant of, the presently claimed product absent evidence that the particular process of making results in a materially different product. Even though product-by-process claims are limited and defined by the process, determination of patentability is based on the product itself. The patentability of the product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See *In re Marosi*, 218 USPQ 289 (Fed. Cir. 1983) and *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985). See also MPEP § 2113.

10. As also previously stated with regard to the substitute composition applied to Rosenski et al., we know through the disclosure of Rosenski et al. that the product in the reference DOES have cohesion and adhesion and function as a PSA. This is only further evidence that applicant has not properly and sufficiently reproduced or represented the invention of the prior art in their Declaration. Thus, the experiments are not sufficient to disparage the teachings of Rosenski et al.

Further, as with Iijima et al. above, the examiner finds no 1-to-1 comparisons within the scope of applicant's claims.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (571) 272-1099. The examiner can normally be reached on M-T (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KELECHI C. EGWIM PH.D.  
PRIMARY EXAMINER  
KCE  
